

**REMARKS**

This is in full and timely response to the Office Action mailed on December 23, 2008.

Claims 1-15 are currently pending in this application.

*No new matter has been added.*

Reexamination in light of the following remarks is respectfully requested

Paragraph 2 indicates a rejection of claims 1-6, and 12-15 under 35 U.S.C. §103 as allegedly being unpatentable *U.S. Patent Application Publication No. 2004/0027942 (Sako'942)* in view of U.S. Patent No. 5,541,902 (Ten Kate).

Paragraph 3 indicates a rejection of claims 7-9 under 35 U.S.C. §103 as allegedly being unpatentable *U.S. Patent Application Publication No. 2004/0027942 (Sako'942)* in view of U.S. Patent No. 5,541,902 (Ten Kate) and in further view of U.S. Patent No. 6,937,549 (Nozaki).

Paragraph 4 indicates a rejection of claim 10 under 35 U.S.C. §103 as allegedly being unpatentable *U.S. Patent Application Publication No. 2004/0027942 (Sako'942)* in view of U.S. Patent No. 5,541,902 (Ten Kate) and in further view of U.S. Patent Application Publication No. 2003/0161233 (Sako'233).

Paragraph 5 indicates a rejection of claim 11 under 35 U.S.C. §103 as allegedly being unpatentable *U.S. Patent Application Publication No. 2004/0027942 (Sako'942)* in view of U.S. Patent No. 5,541,902 (Ten Kate), in further view of U.S. Patent Application Publication No. 2003/0161233 (Sako'233), and in further view of U.S. Patent No. 5,995,704 (Shido).

If the allowance of the claims is not forthcoming at the very least and a new grounds of rejection made, then a **new non-final Office Action** is respectfully requested at least for the following reasons.

This rejection is traversed at least for the following reasons.

**Present application** - The present application was filed after November 29, 1999.

*Sony Corporation* is the real party in interest of the present application. An assignment of all rights in the present application to *Sony Corporation* was executed by the inventor and recorded by the U.S. Patent and Trademark Office at **reel 015678, frame 0806**.

**Sako'942**- *Sony Corporation* is the real party in interest of Sako'942. An assignment of all rights in Satoh to *Sony Corporation* was executed by the inventor and recorded by the U.S. Patent and Trademark Office at reel 014365, frame 0065.

**Common ownership** - The present application and Sako'942 were, at the time the invention of the present application was made, commonly owned by Sony Corporation of Tokyo, Japan. But pursuant to 35 U.S.C. §103(c) and M.P.E.P §706.02(l)(l), **Sako'942 is disqualified as prior art** for the purpose of a rejection under 35 U.S.C. §103.

The Final Office Action acknowledges that Applicant **has provided evidence** in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Sako et al. at the time this invention was made, or was subject to a joint research agreement at the time this invention was made (Final Office Action at page 7).

Nevertheless, the Final Office Action asserts that reference Sako et al. additionally qualifies as prior art under another subsection of 35 U.S.C. §102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c) (Final Office Action as pages 7-8).

In response, 35 U.S.C. §103(c)(l) provides as follows:

(c)(l) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), W, and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Here, no rejection under 35 U.S.C. §102 can be found within the Final Office Action.

In this regard, the Final Office Action has concluded that Sako does not teach:

- Reading back data while the recording of said data by said recording means is in progress (Final Office Action at page 2);
- Verification means for verifying the recording on said information recording medium based on said data stored by said storage means (Final Office Action at page 5);
- Setting means for setting at least one of an exhaustion limit value parameter and a frequency limit value parameter of collective readout for said readout of said data by said readout means in accordance with a communication speed (Final Office Action at page 6);
- Selection means to select at least one of an exhaustion limit value parameter and a frequency limit value parameter of collective readout for said readout of said data by said readout means (Final Office Action at pages 6-7).

Withdrawal of this rejection and allowance of the claims is respectfully requested.

**Official Notice**

There is no concession as to the veracity of Official Notice, if taken in any Office Action.

An affidavit or document should be provided in support of any Official Notice taken. 37 CFR 1.104(d)(2), MPEP § 2144.03. See also, *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989)(failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error).

**Extensions of time**

Please treat any concurrent or future reply, requiring a petition for an extension of time under 37 C.F.R. §1.136, as incorporating a petition for extension of time for the appropriate length of time.

**Fees**

The Commissioner is hereby authorized to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

**Conclusion**

This response is believed to be a complete response to the Office Action. Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers.

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance.

Accordingly, favorable reexamination and reconsideration of the application in light of the remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

Dated: February 11, 2009

Respectfully submitted,

By  40,290

Ronald P. Kananen

Registration No.: 24,104

Christopher M. Tobin

Registration No.: 40,290

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorneys for Applicant